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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,554	10/31/2000	Katsumi Nihei	Q61559	7384

7590 10/23/2003  
Sughrue Mion Zinn Macpeak & SEas  
2100 Pennsylvania Ave N W  
Washington, DC 20037-3202

EXAMINER
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USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/699,554

Applicant(s)

NIHEI, KATSUMI

Examiner

Joseph G Ustaris

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Specification***

1. The abstract is objected to because of the following informalities:
  - The abstract exceeds the maximum word length of 150 words. Please revise the abstract's contents in order to meet the proper format of an abstract.

Appropriate correction is required.

The disclosure is objected to because of the following informalities:

- Page 23 line 24, "5001" should be 5010 in order to match the drawings.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 6, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633).

Regarding claim 1, Bandera et al. discloses a system where advertisements or "advertisement data" are distributed or "broadcasting" to various users over the Internet. The advertisements are selected based on the time of day and/or user's location or

"selection standards for a receive time, a receive position" (See column 7 lines 17-26). The advertisements can be stored on a local cache or "advertisement data base" of a mobile web client (See Fig. 6 element 27; column 9 lines 38-42). The mobile web client changes the advertisements when it detects a change of the time of day and/or user's location or "a reproduction time, a reproduction position" (See column 9 lines 3-19), where the mobile web client would load an advertisement that presents information about something that is closest to the current position of the user or displaying advertisements of "highest evaluation" (See column 7 lines 32-40). The advertisements are presented to the user using web pages (See Fig. 6 element 26). However, Bandera et al. lacks a method where the user's preferences can be used in selecting advertisements.

Park discloses an advertising system where advertisements can be selected based on the user-selected criteria or "preference of the user". The system filters out advertisement that does not satisfy the user-selected criteria and creates a database of advertisements that do meet the user-selected criteria (See Page 16 line 21 – Page 17 line 6). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. to also select advertisements based on the user-selected criteria or "preference of the user", as taught by Park, in order to provide advertisements that are of interest to the user and to filter out advertisements that the user doesn't take interest in.

Regarding claim 2, certain advertisements are loaded and displayed only when the request for advertisements are made within certain time periods or "period of an advertisement" (See Bandera et al. column 7 lines 44-52).

Regarding claim 3, Park discloses a method where a distance-to-travel value or "fixed distance from said location" is calculated using the current position of the vehicle and the position of the geographic point of interest or "advertisement target" (See Page 19 line 23 – Page 20 line 6).

Regarding claim 5, certain advertisements are loaded and displayed only when the request for advertisements are made within certain time periods or "period of an advertisement", wherein the certain advertisements are inherently given priority or "high evaluation" when requested within the time period (See Bandera et al. column 7 lines 44-52). It is assumed that if the request were made outside the certain time period, certain advertisements would not be loaded or given a "low evaluation".

Regarding claim 6, Bandera et al. discloses that the mobile web client would load an advertisement that presents information about something that is closest to the current position of the user or giving advertisements that presents information closest to the user "higher evaluation" (See column 7 lines 32-40). Therefore, advertisements that presents information that is far from the user's position is not loaded or given a "lower evaluation".

Claim 12 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Furthermore, Bandera et al. discloses that the

advertisement system discussed in claim 1 may also be embodied as a computer program product on a computer-usable storage medium (See column 4 lines 29-35).

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633) as applied to claims 1-3, 5, 6, and 12 above, and further in view of Hendricks et al. (US006408437B1).

Regarding claim 4, Bandera et al. in view of Park lacks a method where the user-selected criteria can store key words that are and are not of interest to the user.

Hendricks et al. discloses a set top terminal that receives programs or "advertisements" and is able to search through programs that contain key words, which are and are not of interest to the user. The key words can be stored within a downloaded thesaurus. Any programs that contain key words that are not of interest to the user are excluded (See column 31 lines 5-10 and column 32 lines 42-51). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the user-selected criteria disclosed by Bandera et al. in view of Park to be able to store key words that are and are not of interest to the user, as taught by Hendricks et al., in order to provide a more accurate filtering process when searching through programs or "advertisements".

Claim 7 contains the limitations of claim 4 and is analyzed as previously discussed with respect to that claim. Furthermore, programs that do contain key words of interest are listed or given a "higher evaluation", while programs that contain key

words not of interest are excluded from the list or given a "lower evaluation" (See column 31 lines 5-10 and column 32 lines 42-51).

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US006332127B1) in view of Park (WO 96/04633) as applied to claims 1-3, 5, 6, and 12 above, and further in view of Barnett et al. (US006336099B1) and Rakavy et al. (US006317789B1).

Regarding claim 8, Bandera et al. in view of Park lacks a method where the advertisements are sent within a transmission package or "advertisement transmission row".

Barnett et al. discloses a distribution system for coupons and advertisements where the system can transmit to the user an advertisement package or "advertisement transmission row" (See Fig. 10; column 12 line 29 – column 13 line 3). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. in view of Park to include a system where the advertisements can be transmitted in packages or "advertisement transmission row", as taught by Barnett et al., in order to provide multiple advertisements for future use, thus enabling the mobile web client to make less frequent connections or transmissions for updating.

Claim 9 contains the limitations of claims 1-8 (wherein the system disclosed by Bandera et al. in view of Park is executed by a mobile web client or "advertisement

receiver" and a web server or "advertisement transmitter") and is analyzed as previously discussed with respect to those claims.

Regarding claim 10, Bandera et al. in view of Park lacks a method where the advertisements that are expired and that have been displayed a certain number of times are deleted from the local cache of the mobile web client.

Rakavy et al. discloses an Advertisement Killer or "advertisement deletion processing" that purges advertisements that have been stored for a certain time or "present time outside said period" and advertisements that have been displayed a number of times or "presented a number of times equal to said number" (See column 12 lines 60-67). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the advertisement method disclosed by Bandera et al. in view of Park to include an Advertisement Killer, as taught by Rakavy et al., in order to efficiently use the local cache or "advertisement data base" by freeing up more available space for newer advertisements.

Claim 11 contains the limitations of claims 8 and 9 (wherein the mobile web client disclosed by Bandera et al. in view of Park can also be labeled as an "advertisement receiver") and is analyzed as previously discussed with respect to those claims.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Jonason et al. (US006507949B1) for a similar method of prioritizing the advertisements.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Ustaris whose telephone number is (703) 305-0377. The examiner can normally be reached on Monday-Friday with alternate Fridays off from 7:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for this Group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 305-4700.

JGU  
October 14, 2003

  
ANDREW FAILE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600